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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,216	05/04/2001	Susie J. Wee	10014739-1	9026

7590 07/20/2005

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EXAMINER	
DINH, MINH	

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/849,216	WEE ET AL.	
	Examiner	Art Unit	
	Minh Dinh	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 04/26/2005. Claims 8-10 and 12-14 have been amended.

Response to Arguments

2. Applicant's arguments filed 04/26/2005 regarding the double patenting, 35 U.S.C. 101 and 35 U.S.C 112 (2nd paragraph) rejections have been fully considered but they are not persuasive.

Regarding the double patenting issue, Applicants are required to either file a terminal disclaimer or amend the conflicting claims in order to overcome the double patenting rejection.

Regarding the 35 U.S.C. 101 issue, the claimed data packets comprise a data portion and a header which includes information used by a transcoder. Since there is no functional descriptive language recited in the claims, the data packets are considered "nonfunctional descriptive material" and, therefore, the claims are nonstatutory.

Regarding the 35 U.S.C 112, 2nd paragraph, issue, the information included in the header is used by a transcoder as data but does not cause any functional change to the transcoder. Therefore, the claims are rejected as being incomplete for omitting an element that causes functional change to a device as stated in the preamble.

3. Applicant's arguments, see pages 9-10, filed 04/26/2005, with respect to the rejection(s)of claim(s) 1-2, 4-10 and 12-16 under 35 U.S.C 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, a discovery of new prior art has necessitated new grounds of rejection. The delay in citation of the newly discovered prior art is regretted.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-2, 4-10 and 12-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/245172 in view of Bachtiar et al ("A Secure Video On Demand System").

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application is obvious in view of the copending application. The copending application discloses the same limitations as the present

application with two exceptions: (a) the data portion being progressively encrypted; and (b) the header enabling the transcoder to transcode the encrypted data portion without decrypting/re-encrypting the data portion.

Bachtiar discloses video data portion being progressively encrypted (Abstract; fig. 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the encryption technique, as taught by Bachtiar, so as to prevent unauthorized access to the data.

Since the transcoder in the copending application can transcode the data portion without decoding/re-encoding the data portion, there is no need for the transcoder to decrypt/re-encrypt the data portion. Therefore, the limitation "the header enabling the transcoder to transcode the encrypted data portion without decrypting/re-encrypting the data portion" is obvious in view of the above combination

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a data packet stored in a computer readable medium, the data packet comprising a data portion and a header data portion including information used by a transcoder. Since there is no

functional descriptive language recited in the claims, the data packets are considered "nonfunctional descriptive material" and, therefore, the claims are nonstatutory.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the instruction or code that causes a functional change in the operation of a device as stated in the preamble.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Der Vleuten et al (2002/0076043) in view of Spanos et al ("Performance Study of a Selective Encryption Scheme for the Security of Networked, Real-Time Video").

Regarding claim 1, Van Der Vleuten discloses MPEG4 or JPEG packets received by a transcoder, said data packets comprising a scalably encoded data portion

(paragraphs 0002-0004, 0011, 0044); and a header data portion corresponding to said scalably encoded portion, said header data portion including information adapted to be used by the transcoder to efficiently transcode said scalably encoded data portion (paragraphs 0010-0011, 0023, 0025, 0044). Van Der Vleuten does not disclose that the data portion is progressively encrypted. Spanos discloses that encoded video data is progressively encrypted (Abstract; page 4, left column, last paragraph). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Van Der Vleuten packet such that the data portion is progressively encrypted, as taught by Spanos, so as to prevent unauthorized access to the data.

Regarding claim 2, Van Der Vleuten further discloses a truncation point identified within the data portion, said identified truncation point enabling a transcoder to perform efficient transcoding of said data packets (paragraphs 0002-0003).

Regarding claim 3, Van Der Vleuten does not disclose that the header portion is encrypted. Spanos discloses encrypting headers to conceal decoding initialization parameters (p. 3, right col., last paragraph). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Van Der Vleuten packet such that the header is encrypted, as taught by Spanos, so as to conceal decoding initialization parameters and the identity of the stream.

Regarding claims 6-7, Van Der Vleuten further discloses that the transcoder can do the transcoding without decoding/re-encoding the scalably encoded data portion (paragraphs 0002-0003).

Regarding claim 8, Van Der Vleuten further discloses that the packet is received and processed by an intermediate device or a client device (paragraph 0023).

Regarding claim 9, Van Der Vleuten further discloses that the data portion is video data or audio data (paragraph 0006).

Allowable Subject Matter

11. Claims 4-5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101 and U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. An appropriate terminal disclaimer to overcome the double patenting rejection is also to be filed.

12. Claims 10 and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. An appropriate terminal disclaimer to overcome the double patenting rejection is also to be filed.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,838,791 to Torii et al.

U.S. Patent No. 6,442,207 to Nishikawa et al.

U.S. Patent No. 6,671,416 to Vishwanath et al.

U.S. Patent No. 6,763,460 to Hild et al.

14. If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge will not apply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh
Examiner
Art Unit 2132

MD
7/14/05

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